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10/566,836	02/02/2006	Tatsuya Shimoji	2006-0114A	7518
52349 7590 04/29/2010 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER JOHNS, CHRISTOPHER C				
ART UNIT 3621		PAPER NUMBER		
NOTIFICATION DATE 04/29/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/566,836

Applicant(s)

SHIMOJI ET AL.

Examiner

Christopher C. Johns

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Acknowledgements

1. This Office Action is given Paper No. 20100414 for reference purposes only.
2. This Office Action is in response to the Response to Non-Final Office Action, filed by Applicants on 20 November 2009, and to the Supplemental Amendment, filed by Applicants on 21 January 2010.
3. Claims 16-20 are pending.
4. Claims 16-20 have been examined.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
7. Under the broadest reasonable interpretation standard, claim 17 recites a computer program only. "Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor statutory processes, as they are not 'acts' being performed." MPEP §2106.01 I.

8. Because the claim recites only abstractions that are neither “things” nor “acts,” the claims are not within one of the four statutory classes of invention.¹ Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101.

9. In this particular case, the “server” in claim 17 is broad enough to encompass being only a software “server”. As such, the claim encompasses “software” alone, and is therefore not statutory.

Claim Rejections - 35 USC § 112 1st Paragraph

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

12. Independent claims 19 and 20 recite “a computer-readable storage medium”. There is insufficient support for this recitation in the specification, drawings, or claims as originally filed;

¹ 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define “things” (or products) while the first category defines “actions” (i.e., inventions that consist of a series of steps or acts to be performed).

Claim Rejections - 35 USC § 112 2nd Paragraph

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Independent claim 16's recitation of "each of the sub-licenses manages together one or more keys" (page 2, lines 15-17) renders the claim indefinite because a person having ordinary skill in the art would not understand whether this means:

- a. "each of the sub-licenses" manages every key (i.e. in a system with three licenses and three keys, license A manages keys 1, 2, and 3; license B manages keys 1, 2, and 3; license C manages keys 1, 2, and 3); or
- b. "each of the sub-licenses" manages a respective key (i.e. in the above system, license A manages key 1, license B manages key 2, license C manages key 3).
- c. Because a person having ordinary skill in the art would not understand whether the licenses manage their own keys, or manage all keys, said person would not know how to implement the claimed invention, rendering the claim indefinite. Claims 17-20 recite similar limitations and are therefore similarly rejected.

16. Independent claim 16's recitation of "one or more keys having encrypted one of the plurality of resources..." (page 2, lines 15-17) renders the claim indefinite because a person having ordinary skill in the art would not understand whether this means:

- d. each sub-license manages keys, wherein said keys have previously been used to encrypt resources; or
 - e. each sub-license manages keys, and each sub-license has also previously encrypted some of the “plurality of resources”.
 - f. Because a person having ordinary skill in the art would not understand whether the keys are used to encrypt resources, said person would not know how to implement the claimed invention, rendering the claim indefinite. Claims 17-20 recite similar limitations and are therefore similarly rejected.
17. Independent claim 16’s recitation of “key bunch of decryption keys for decoding the content or the corresponding sub-license when encrypted” renders the claim indefinite because a person having ordinary skill in the art would not understand whether:
- g. the “when encrypted” phrase is meant to apply to the “content” and the “sub-license” portions of the claim (necessarily implying that the content *could* be unencrypted); or
 - h. the “when encrypted” phrase is meant to only apply to the “sub-license” portion of the claim (necessarily implying that the content *must* be encrypted).
 - i. Because a person having ordinary skill in the art would not understand whether the content must be encrypted, said person would not know how to implement the claimed invention, rendering the claim indefinite. Claims 17-20 recite similar limitations and are therefore similarly rejected.
18. Independent claim 16’s recitation of “an upper-level resource that is first referred to...” (page 2, line 5) renders the claim definite because it is not clear what is doing the “referring”. A

person having ordinary skill in the art would not understand what “refers” to the resource, nor how it refers to the upper-level “first”. Because a person having ordinary skill in the art would not understand what “[refers]” to the upper-level resource, nor how it is referred to “first”, said person would not know how to implement the claimed invention, rendering the claim indefinite. Claims 17-20 recite similar limitations and are therefore similarly rejected.

19. In claims 16-20, the phrase “key bunch” is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase cannot be reasonably determined. To support this position, the Examiner notes the following: First, the Examiner has carefully reviewed the original specification and cannot locate a lexicographic definition with the required clarity, deliberateness, and precision. Second, although the Examiner recognizes that each word within the phrase may have a particular meaning, the arrangement of these words within the context of this phrase does not reasonably apprise one of ordinary skill in this art the overall meaning of the claimed phrase. Third, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03 including the original specification and claims.

20. Therefore, based at least upon the three points noted above and using the required precepts of English grammar, it is the Examiner’s position that the phrase “key bunch” (as used in the context of these particular claims) is neither lexicographically defined by Applicants nor known to those of ordinary skill in this art.

21. However, if Applicants believe that the phrase *is* old and well known in the art, Applicants should (in their next appropriately filed response) expressly state on the record that the phrase is old and well known in the art *and* provide appropriate evidence in support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicants’ express statement that the phrase is old and

well known in the art *and* (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. § 112, 2nd paragraph rejection.

22. Claim 17 is indefinite because a person having ordinary skill in the art would not understand whether Applicants are claiming the subcombination of a “server,” or the combination of a “server” and a “content.”

23. The preamble of claim 17 indicates that the claim is drawn to a “server” (“A server that stores a content...”; page 6, lines 1-2). Furthermore, claim 17 recites limitations of the server, such as “wherein the server comprises” (page 8, line 23).

24. The body of claim 17 positively recites a “server” in combination with a “content”. See page 6, line 3 - page 8, line 22, which starts “wherein the content includes...”.

25. Because the preamble indicates that the claim is drawn to only a “server”, and the body of the claim is drawn to a “server” in combination with “content”, the claim is indefinite.

26. If it is Applicants’ intention to claim the combination of a “server” in combination with a “content”, the preamble of the claim must be amended to indicate that the scope is a combination of a “server” in combination with a “content”. For example, Applicants could amend the preamble to read “A system....”

27. If it is Applicants’ intention to claim the subcombination of a “server” alone, then all positive recitations concerning the recited “content” must be removed from the claim. Claims 18-20 are rejected for similar reasoning.

28. The Examiner finds that because the claims are indefinite under 35 U.S.C. § 112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP § 2173.06 and the USPTO’s policy of trying to advance prosecution by providing art

rejections even though claims may be indefinite, the claims are construed and the prior art is applied as much as practically possible.

Allowable Subject Matter

29. Claims 16-20 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C 101 and 35 U.S.C. 112, 1st and 2nd paragraphs, as set forth in this Office action.

Conclusion

30. Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that - suggestions or examples - and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action, or in any future Office Action, does not constitute a formal requirement mandated by the Examiner.

j. Should Applicants decide to amend the claims, Applicants are also reminded that - as always - no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. §112, 1st paragraph.

k. Independent of the requirements under 35 U.S.C. §112, 1st paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an

objection to the specification may result. Therefore, in these rare situations where the amended claim language does not have clear support or antecedent basis in the specification and to prevent a subsequent 'Objection to the Specification' in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims do have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP § 608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that - as always - no new matter in the specification is allowed. See 35 U.S.C. § 132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

31. Applicant's amendment, filed on 21 January 2010, necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

32. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The Examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621